

#16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Office of Petitions

Applicant:	Michael Reed et al.	:	Confirmation No. 3543
		:	
Serial No.:	08/113,955	:	Art Unit: UNASSIGNED
		:	
Deposited:	August 31, 1993	:	Examiner: UNASSIGNED
		:	
For:	MULTIMEDIA SEARCH SYSTEM	:	

**OPPOSITION TO**  
**"PETITION UNDER 37 C.F.R. §1.53(b) and/or 37 C.F.R. §1.182 FOR**  
**GRANT OF A FILING DATE AND AMENDMENT OF APPLICATION"**

**I. PRELIMINARY OVERVIEW:**  
**PETITIONER HERSHKOVITZ SEEKS TO REWRITE HISTORY**

Petitioner Hershkovitz says (page 2) that the Dickstein law firm (hereinafter "Dickstein") "desired" to meet the statutory copendency requirement but encountered unexplained difficulties (deemed not to be relevant), resulting in an abandoned, incomplete application. The Petitioner, inspired by current litigation, will go to any length to avoid having a Federal Court rule against his principal, Encyclopaedia Britannica, on this break in copendency. Blaming "haste," "staff," and the "attorney reviewing the filing" for breaking the copendency, failing to pay a filing fee, omitting a surcharge fee for excess claims, excluding a Declaration, filing an incomplete application, declining to respond to a PTO decision denying a filing date or appeal that decision, and utterly failing to claim priority to an earlier application, Petitioner now asks the PTO for a mulligan. Petitioner is not the U.S. Congress, however, and cannot amend the Patent Statute and arrogate to itself a loophole to evade the copendency requirement. As shown below, the PTO has already ruled that the incomplete application never received a filing date; the public relied on that ruling; and companies which have been wrongfully sued for patent infringement have asked a Federal Court to follow that ruling.

## II. RELIEF REQUESTED

The undersigned Opposer requests that the Office of Petitions (1) consider this Opposition; and (2) either (a) dismiss as untimely or (b) deny the "Petition under 37 C.F.R. §1.53(b) and/or 37 C.F.R. §1.182 for grant of a filing date and amendment of application" filed November 1, 2007, by Petitioner Abraham HersHKovitz. The Office of Petitions is further requested (3) to declare (a) that the papers deposited August 31, 1993, and assigned Serial No. 08/113,955, are not entitled to a filing date, and (b) that any claim to the priority of Serial No. 08/113,955 is void.

## III. LITIGATION BACKGROUND:<sup>1</sup> PETITIONER'S SUBMARINE PATENT APPLICATIONS

One thing is agreed: U.S. Patent 5,241,671 issued on August 31, 1993, from an application filed October 26, 1989. Because the litigation plaintiff (Encyclopaedia Britannica) is behind the Petition<sup>2</sup>, however, much of what happened later was conveniently omitted. Here is the untold story.

Disturbed by the breadth of the '671 patent issued to Encyclopaedia Britannica, the PTO and then-Commissioner Lehman ordered a reexamination in December 1993. As a consequence of an eight-year reexamination, many rejections by the PTO, and substantial claim amendments and disavowal of claim scope by the applicant, Encyclopaedia Britannica was issued an *encyclopedia* reexamination certificate in 2002.

Failing for years in its attempts to license the encyclopedia patent, Encyclopaedia Britannica sued car *navigation* companies for patent infringement on May 16, 2005. Almost sixteen (16) years after the filing date of the '671 patent, with the accused products in one hand and draft claims in the other, Encyclopaedia Britannica filed three continuation applications on June 13, 2005, ostensibly to

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<sup>1</sup> Additional factual background from the litigation is presented below in part IV.B, pages 10-11, and in Appendix A, pages A2-A3.

<sup>2</sup> The present petition filed by HersHKovitz is referred to as the "Petition". The earlier petition filed in 1994 is referred to as the "Grossman Petition".

rewrite the encyclopedia-like claims resulting from the Commissioner-ordered reexamination and, thereby, hopefully to read on car navigation products.

There was at least one insurmountable hurdle: a break in copendency. Contrary to what Petitioner now says in hopes of a "do over," the incomplete, abandoned '955 "application" became public – as the PTO knows – when Encyclopaedia Britannica tried to claim priority to it in a later issued patent.

So, did Encyclopaedia Britannica in the submarine applications 'fess up to the PTO's earlier denial of a filing date for the '955 incomplete application? Of course not. It banked on the PTO not digging through a prosecution history from 1993 amidst a patent family whose lineage had an eight-year reexamination and voluminous records from that prosecution history.

But when a patentee sues many defendants for substantial sums of money, these skeletons tend to be discovered. When Encyclopaedia Britannica was issued the continuation patents 7,051,018 and 7,082,437 in 2006 and rushed into Federal Court to assert them against the car navigation products, then defendant Alpine, in its 2006 answers as filed in Federal Court, alleged the break in copendency as a basis of invalidity of these continuation patents under 35 U.S.C. § 120.

If the Petition to accord a filing date seems déjà vu, it is. As discussed more fully below at pages 5-7, the PTO flatly dismissed Encyclopaedia Britannica's earlier attempt in 1994 to give the '955 incomplete application a filing date of August 31, 1993, the day the '671 patent issued. And the Federal Court is now considering a request by defendants who are asking the court to follow the PTO's earlier ruling.

In sum, the PTO recognized in 1993 how ill-advised patents can have grave consequences to our nation. That is no less true today. Motivated by litigation to attempt an end-around the Federal Court, Encyclopaedia Britannica should not have another chance to undo the PTO's 1994 decision on the filing date issue.

#### **IV. STATEMENT OF FACTS**

##### **A. The Parties**

Briefly, the parties include the purported owner (Encyclopaedia Britannica) of the '955 incomplete application, the attorneys for the '955 incomplete application, the Petitioners, and the Opposer. The parties are explained in greater detail in Appendix A, pages A1-A2.

##### **B. Prosecution of the '955 incomplete application**

The following facts in Paragraphs 1-10 are shown by file histories and other records in the U.S. Patent and Trademark Office.

1. Michael Reed and 13 others filed U.S. Patent Application Serial No. 07/426,917 on October 26, 1989, and assigned that application to Encyclopaedia Britannica, Inc.<sup>3</sup> The application was allowed and issued on August 31, 1993, as the '671 patent. The status of that application (hereinafter, the '671 patent application) and the '671 patent is not questioned in the Petition or this Opposition.

2. On August 31, 1993, the very day that the '671 patent was issued, Dickstein deposited a first set of papers apparently intended to constitute a continuation application of the '671 patent application. This first set of papers, called the "1<sup>st</sup> sandwich application" in the Petition – but more accurately the "first incomplete application" – is said in the Petition to have included an incomplete specification (missing page 1), drawings, a filing fee, an inventors' declaration, and a preliminary amendment which included a claim to priority of the '671 patent application. This first set of papers was assigned Serial No. 08/113,898, and a PTO receipt date of August 31, 1993, the status of which is not questioned in the

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<sup>3</sup> The assignment would apply to the '955 incomplete application if it were a continuation of the '671 patent application, but the '955 incomplete application never claimed priority of any earlier application, and it is now too late to do so.

Petition, as it was expressly abandoned on October 29, 1993, without having been accorded a filing date.

3. Also sometime on August 31, 1993, the Petition contends that Dickstein deposited a second set of papers apparently intended to constitute a continuation of the '671 patent application. This second set of papers, called the "2<sup>nd</sup> sandwich application" in the Petition – but more accurately the "second incomplete application" – is said in the Petition to have included an incomplete specification (missing page 1) and drawings,<sup>4</sup> but no filing fee, no inventors' declaration, and no claim to priority to the '671 patent application. There was also apparently no power of attorney. This second incomplete application was assigned Serial No. 08/113,955, and the Petition relates to this '955 incomplete application.

4. On September 14, 1993, the PTO sent two papers (together constituting Paper 2 in the file) to Dickstein regarding the second, '955, incomplete application. The first paper was a NOTICE OF INCOMPLETE APPLICATION, Form PTO-1123, stating that a filing date had NOT been assigned to the '955 incomplete application, because the specification was missing page 1. A term of two months in which to file the missing page was set, and the first NOTICE stated that the filing date of the Application would be the date on which the missing page was received. The second paper was a NOTICE TO FILE MISSING PARTS OF APPLICATION / NO FILING DATE (Enclosure to Form PTO-1123), stating that a filing fee of \$2156 and an inventors' oath or declaration were missing. The second NOTICE said the missing filing fee and declaration should be submitted with the missing page required in the first NOTICE, and repeated that the filing date of the Application would be the date on which the missing page was received.

5. On October 29, 1993, Jon D. Grossman of the Dickstein firm filed a PETITION FOR GRANTING A FILING DATE (the "Grossman Petition"), a petition fee

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<sup>4</sup> The incomplete specification and drawings were apparently discarded by the PTO.

of \$130.00, and a preliminary amendment in the '955 incomplete application (together constituting Paper 3 in the file). The missing specification page 1 was not provided. No claim for priority of an earlier application was made. The missing filing fee was not provided. The missing inventors' oath or declaration was not provided. No power of attorney was provided. Mr. Grossman stated that page 1 "is not necessary for an understanding of the subject matter sought to be patented or for the support of the claims", and requested acceptance of the Application without the missing page 1. Although the second pages of the copies of the Grossman Petition, the Preliminary Amendment, and the 1994 DECISION ON PETITION mailed February 16, 1994, previously available on PAIR IFW, are truncated, the complete Grossman Petition shows that he made no mention of the filing fee for the incomplete application. Grossman alleged that "An Oath or Declaration will also be filed [later]"<sup>5</sup>, but no filing fee or Declaration was ever filed in the '955 incomplete application. The preliminary amendment requested deleting the incomplete sentence at the top of page 2 of the specification, but neither the amendment nor the Grossman Petition added a claim for priority of any earlier Application. The preliminary amendment merely stated in conclusory fashion that the '955 incomplete application was "now in condition for examination", but that was not the case for *at least* the reasons that no filing fee, Oath or Declaration was ever filed.

6. On February 16, 1994, the Grossman Petition was dismissed without prejudice. The 1994 DECISION ON PETITION (Paper 4 in the file) said very clearly what needed to happen for the '955 incomplete application to be accorded an August 31, 1993, filing date, as requested:

(1) *If the inventors agreed* that page 1 is unnecessary for an understanding of their invention, they needed to file an oath or declaration (a) complying with 37 CFR § 1.63 (*i.e.*, the regular inventors' oath or declaration) and (b) including a statement that their

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<sup>5</sup> Complete (*i.e.*, untruncated) copies of the Grossman Petition, the Preliminary Amendment filed October 29, 1994, and the DECISION ON PETITION mailed February 16, 1994, are enclosed in Appendix B to this Opposition.

invention is adequately disclosed in, and their wish to rely on, the specification without page 1.

(2) A patent application filing fee of \$2156.00 (plus a surcharge of \$130.00, if applicable) needed to be filed. A response was required within two months, *i.e.*, by April 16, 1994.

But not one of these requirements was ever filed in the '955 incomplete application.

7. On February 28, 1994, Grossman filed a request for a four-month extension of time, captioned "Serial No.: Rule 53 Continuation of 08/113,955", apparently together with a check for the extension fee. The request for extension of time did not specify what period of time was sought to be extended, but it was apparently construed as a request for extension of time to respond to the 1994 DECISION ON PETITION, and filed in the '955 incomplete application as Paper 5 in the file. A response to the 1994 DECISION ON PETITION was *never* filed until the Petition in 2007, so the '955 incomplete application was abandoned *ab initio* as an *incomplete application*.

8. On March 23, 1995, the PTO sent Dickstein a NOTICE OF ABANDONMENT UNDER 37 CFR 1.53 (Paper 6 in the file), stating that the '955 incomplete application had been abandoned, and did not comprise a complete application. Papers 7 and 8 in the file are public requests to access the file.

9. On November 1, 2007, the present Petition was filed by Petitioner. The Petition contains many incorrect statements:

(a) Petitioner states that the "copendency requirement of 35 U.S.C. §120 was met." (Petition, page 2). Wrong. To meet the copendency requirement, the papers had to be filed by August 31, 1993, the issue date of the '671 patent. Neither 08/113,898 nor the '955 incomplete application was ever accorded a filing date, so they were not "filed" by August 31, 1993.

(b) Petitioner would have the PTO believe that the '955 incomplete application "was filed under 37 C.F.R. §1.53." (Petition, page 3). No. It was "deposited", but never filed, because the procedures to qualify for a filing date were never completed.

(c) Petitioner contends the later-filed application Serial No. 08/202,985 "was issued on April 8, 2003, as a continuation" of the '955 incomplete application and the '671 patent application. (Petition, page 4). Not so. The '955 incomplete application was not a complete application, was never accorded a filing date to be used as a continuation of a later-filed patent application, and was never copending with the '671 patent application or the 08/202,985 application.

(d) Remarkably, Petitioner blames the PTO for not picking up "an inadvertent oversight ...by Applicant." (Petition, page 4). This is yet another bald assertion insufficient to show the *applicant's* 13-year delay in meeting statutory requirements was unavoidable. Even focusing on the PTO, the PTO clearly put the applicant on notice of what to do to get a filing date. But did anyone follow those instructions? No. And now, motivated by litigation, Encyclopaedia Britannica wants another chance. Simply put, Petitioner offers no proof the failure to file an inventor's declaration, a declaration by the inventors confirming that they agreed to proceed without page 1, a filing fee, or a substantive response to the 1994 DECISION ON PETITION, was an inadvertent oversight. To the contrary, the evidence shows the PTO communicated these requirements to Grossman acting as a representative of the inventors, and that Grossman's lack of action was deliberate.

(e) Petitioner asserts that "Applicant was not alerted to any filing date or priority benefit problems." (Petition, page 5). Wrong. Not only were they alerted by the notice of incomplete application and notice of missing parts, but also these problems formed the crux of the Grossman Petition and the PTO's decision on that Petition.



(f) The Petition implies at page 6 that it may be considered on the merits, in spite of being filed more than two months – indeed, more than **13 years** – after the 1994 DECISION ON PETITION. Incorrect. 35 USC § 133 mandates abandonment for “failure ... to prosecute ... within six months after any action therein...unless it be shown to the satisfaction of the Director that such delay was unavoidable.” No such showing was attempted. On the contrary, Petitioner admits the '955 incomplete application “was eventually **permitted to go abandoned** ...” (Petition, page 3) (emphasis added).

(g) Another incredible contention appears on page 6. Petitioner says Encyclopaedia Britannica waited 13 years to claim priority to the '671 patent application because it “was not alerted” to the legal requirement. The responsibility to claim priority rests with the Applicant, and Applicant cannot shift that responsibility to the PTO. Grossman is not excused from responding to the 1994 DECISION ON PETITION, which required – for an August 31, 1993, filing date – a request for reconsideration; an inventors' oath or declaration in compliance with 37 CFR § 1.63; an inventors' oath or declaration that their invention is adequately disclosed in, and that they wish to rely on, the specification without page 1; and the patent application filing fee. None of these was ever filed.

(h) Petitioner inaccurately claims that “the general public could not have relied on a belief that priority benefits were not being claimed [in the '955 incomplete application] since that application was not publicly available.” (Petition, page 6). But it was available at least by April 8, 2003, with the issuance of USP 6,546,399; it was available when Encyclopaedia Britannica filed its 2005 lawsuit; and the PTO records show that the '955 incomplete application was in fact accessed by the public. See Paper Nos. 7 and 8.

(i) Petitioner implies that the PTO should retroactively apply later adopted practices in this case. (Petition, page 7). No, it should not. The '955

incomplete application had to comply with procedures in effect at the time it was deposited.

(j) An "extension of time fee" was not "tendered on February 28, 2004" in the '955 incomplete application, as claimed by the Petition, page 7.

(k) Petitioner authorizes that the '955 incomplete application be deemed abandoned "effective February 29, 1994." (Petition, page 8). That date does not exist. Also, the '955 incomplete application was abandoned *ab initio*.

**B. A Federal Court Is Considering Defendants' Request to Follow the PTO's Earlier Decision that Denied the '955 Incomplete Application a Filing Date**

After filing the present Petition, Encyclopaedia Britannica responded to the Federal Court, and Defendants replied. The arguments are summarized below.

<b>Encyclopaedia Britannica (EB)</b>	<b>Defendants Showed that EB Is Wrong</b>
1 The '955 incomplete application was entitled a filing date when an incomplete specification and drawings were deposited with the PTO.	Prescribed conditions were never met: A declaration, filing fees, and resolution of the missing page 1, were required. PTO decisions held that the application was not entitled a filing date.
2 The PTO later changed its policy regarding applications filed with missing pages, without a change to 35 USC § 111.	The '955 incomplete application needed to comply with law and procedures in effect when it was deposited, and at the time of the PTO 1994 DECISION ON PETITION, which is law of the case.
3 The PTO PAIR system shows a filing date of August 31, 1993.	First, PAIR is not controlling—the Patent Statute is. Second, PAIR shows that '955 was and remains an incomplete application.

## **Encyclopaedia Britannica (EB)**

- 4 An extension-of-time request filed Feb. 28, 1994, included a deposit account authorization that could be construed as paying the filing fee.
- 5 The 2007 Petition agrees to pay any fees, including processing fees for the 1993 application.
- 6 USP 6,546,399 issued in 2003 alleged that the '955 incomplete application was a continuation of the '671 patent application of 1989, so the '955 incomplete application did not need to do so.
- 7 In one paper to the Federal Court, EB argues that defects in the '955 incomplete application are correctable by the 2007 Petition.
- 8 In another paper to the Federal Court, EB argues that the 2007 Petition does not attempt to "cure" any defects, because there were none.
- 9 The 2007 Petition has not yet been denied.

## **Defendants Showed that EB Is Wrong**

No paper authorized a filing fee to be charged to the account. This paper authorized fees in connection with extensions of time only—not a filing fee or a surcharge for excess claims. These fees were never paid. It is too late to do so now.

No paper previously authorized, or was construed to authorize, a filing fee. It is too late to do so now.

Noting that EB admitted that the '955 incomplete application did not contain a claim for priority, alleging a claim to priority in a later application was not a substitute for claiming priority in the '955 incomplete application.

The PTO already heard and rejected the 1994 petition for a filing date. It is now too late to appeal that decision or to correct defects of an incomplete, abandoned 1993 application.

(There was no opportunity to traverse in Court – but if there were no defects, the Petition should be dismissed or denied.)

(There was no opportunity to traverse in Court – but the Office of Petitions is urged to deny the Petition now.)

Copies of the briefs referred to above will be provided on request.

## **V. PETITIONER SHOULD NOT BE ALLOWED A "DO OVER" THAT CHANGES HISTORY SO ENCYCLOPAEDIA BRITANNICA CAN SUE**

### **A. This Opposition Should Be Considered if the Petition Is Considered**

Petitioner has no explicit authority to file the petition: No inventors' declaration, assignment, or power of attorney is of record. Without any of these requirements, the Petition is filed under 37 C.F.R. § 1.182, "Questions not specifically provided for."

If the Petition is considered by the PTO under Rule 182, then this Opposition should also be considered under that rule, which says "All situations not specifically provided for in the regulations of this part [of the Rules governing patent prosecution] will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing...." When a petition is filed "attempting to limit, by petition to the PTO, the issues that must be litigated before [the U.S. District] Court", as Encyclopaedia Britannica is doing in this case, a reasonable requirement to be imposed is that argument on behalf of other litigants be heard. Deciding the question without considering the opposing viewpoints, however, is fraught with danger.

Indeed, whether later-filed patent applications and issued patents may claim priority of the incomplete, abandoned '955 incomplete application – as suggested by the Petition – is a question reachable by reexamination as a substantial new question of patentability not considered in the prosecution of the various applications that claim priority. The question is, however, much more efficiently reached by considering the Petition (if not dismissed) in conjunction with this Opposition.

**B. The Petition Should Be Denied as Untimely**

35 USC § 133 requires that for "failure ... to prosecute ... within six months after any action therein...", Serial No. 08/113,955 be "regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable." No such showing has been attempted, nor does Petitioner even urge that the abandonment was unintentional. On the contrary, Petitioner admits that "[Serial No. 08/113,955] *was eventually permitted to go abandoned ....*" (page 3, emphasis supplied).

Apart from the statutory requirements, there is the question of laches, which Petitioner mentions at page 8, but does not address except to try to minimize the extraordinary relief that is sought in the Petition. After more than 13 years, laches in prosecuting Serial No. 08/113,955 has surely set in.

If the Petition is dismissed as untimely, however, it is urged that the decision dismissing it should make clear that that the papers deposited August 31, 1993, and assigned Serial No. 08/113,955, are NOT ENTITLED TO A FILING DATE, and that any claim to the priority of Serial No. 08/113,955 is void.

**C. The Petition, if Deemed Timely, Fails to Comply with the PTO's 1994 Decision**

The Petition seeks a filing date. Proponents of the '955 incomplete application have been here before – *twice*. First, Dickstein deposited papers apparently intended to constitute a continuation of the '671 patent that issued August 31, 1993. This set of papers included an incomplete specification (missing page 1), no filing fee or excess claim fee, no inventors' declaration, no claim to priority of the '671 patent application, and no power of attorney. The PTO assigned a Serial Number, and on September 14, 1993, sent Dickstein two papers clearly stating what must happen for a filing date to be assigned. Dickstein **did not** comply with the September 14, 1993, Notices from the PTO, but instead, filed the Grossman Petition. The PTO dismissed the Grossman Petition without prejudice, and in the 1994 DECISION ON PETITION, again spelled out clearly what needed to

happen for a filing date to be assigned. Again, Dickstein **did not comply** with the 1994 DECISION ON PETITION. Instead, a four-month extension of time was filed, captioned "Serial No.: Rule 53 Continuation of 08/113,955", apparently together with a check for the *extension* fee. The Commissioner was authorized to charge any fee "in connection with this communication" to a deposit account. A conditional further extension request was included, together with an authorization to charge "Any fees" to the same deposit account, Encyclopaedia Britannica now argues in Court to have authorized payment of the filing fee. But Dickstein also **did not file an inventors' declaration, a confirmation by the inventors that they wished to proceed without the missing page of specification, or an explicit filing fee.**

Dickstein did not request reconsideration of the 1994 DECISION ON PETITION, or appeal the decision, or seek any further review of any kind, inside or outside the PTO. The 1994 DECISION ON PETITION is now law of the case, not subject to further negotiation. No one has complied with the requirements for a filing date set forth in the 1994 DECISION ON PETITION, either in 1994 or 2007, and it is now too late to do so.

**1. The '955 Incomplete Application Does Not Comply with 35 USC § 111(a)(4)**

Section 111(a)(4) requires that, "Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional." The fee and oath were not submitted. It is now too late to do so.

**2. The Late Claim for Priority to the '955 Incomplete Application Does Not Comply with 37 CFR § 1.78(a)(2)(ii)**

37 CFR § 1.78(A)(2)(ii) requires that reference to the application whose priority is claimed, be submitted in an application claiming priority of a previous

application, "during the pendency of the later-filed application", and also "within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application." The incomplete '955 incomplete application was abandoned *ab initio*. Applicant failed to respond to the 1994 DECISION ON PETITION by April 16, 1994 (the two-month period), by August 16, 1994 (assuming a four-month extension), or ever.

In any event, it is now over 13 years too late to meet either the "during the pendency of the later-filed application" limitation, or the "four months from the actual filing date of the later-filed application" limitation, if an August 31, 1993, filing date were to be accorded to the '955 incomplete application. Without the claim to priority, the Petition is pointless, and the continuation applications that Encyclopaedia Britannica is asserting in Federal Court are invalid as anticipated by its own International Publication WO 91/06916, published May 16, 1991. That is what the Federal Court is deciding, and why it should now be clear to the PTO why Encyclopaedia Britannica will go to any length to undo the PTO's earlier decision that the '955 incomplete application never got a filing date.

## VI. CONCLUSION

The so-called '955 "application" was deposited with an incomplete specification, no filing fee, no excess claim fee, no inventors' declaration, no claim to priority, and no power of attorney. The attorneys who deposited it were given ample opportunity to cure its defects. They did not do so, and their action appears to have been deliberate.

The incomplete application was intentionally allowed to go abandoned. Members of the public have inspected the file, and reached conclusions as to the validity of patents claiming priority to that '955 incomplete application based on what was in the file of that application. The equities lie on the side of the public who relied on the file contents, rather than with Encyclopaedia Britannica.

Unavoidability requires more than a litigation-inspired "desire" to meet statutory copendency requirements. Allowing an attempt to comply more than 13

years later – after an incomplete application has been abandoned – would turn the public notice function of patents on its head. Responsibility rested on the Applicant to ensure its application was in compliance at the time of filing, and a reasonably prudent person would have complied with the PTO's 1994 decision. Petitioner cannot show a 13-year unavoidable delay by ducking its obligations then and now by blaming "haste," "staff," the "attorney reviewing the filing" and even the PTO.

Encyclopaedia Britannica has told the Federal Court that no corrective action is required, but at the same time, Petitioner is trying to snooker the PTO into granting relief that Encyclopaedia Britannica desperately needs, but does not deserve.

The Petition should not be granted.

Respectfully submitted,

/Raymond W. Green/  
Raymond W. Green  
Registration No. 24,587  
Opposer

BRINKS HOFER GILSON & LIONE  
P. O. Box 10395  
Chicago, Illinois 60610  
312-321-4200

Dated: January 9, 2008

#### CERTIFICATE OF SERVICE

I certify that on January 9, 2008, copies of the foregoing Opposition and Appendices A and B were served by first class mail, postage prepaid, to:

(1) Dickstein Shapiro LLP, 1825 Eye Street NW, Washington DC 20006-5403, correspondence address for Serial No. 08/113,955; and

(2) Abraham HersHKovitz, HersHKovitz & Associates, LLC, 2845 Duke Street, Alexandria, VA 22314, Petitioner.

/Raymond W. Green/  
Raymond W. Green  
Registration No. 24,587



## **APPENDIX A**

### **STATEMENT OF DETAILED FACTS**

#### **A. THE PARTIES**

1. **Purported Owner of Serial No. 08/113,955:** No assignment of Serial No. 08/113,955 appears to have been filed. However, Petitioner seeks to claim priority, in Serial No. 08/113,955, of Application Serial No. 07/426,917, filed October 26, 1989, and issued August 31, 1993, as U.S. Patent 5,241,671, which is assigned to Encyclopaedia Britannica, Inc. The papers deposited August 31, 1993, and assigned Serial No. 08/113,955, were deposited by an attorney (Jon D. Grossman), of a law firm (Dickstein, Shapiro & Morin) that had acted for Encyclopaedia Britannica, Inc. in Application Serial No. 07/426,917 and U.S. Patent 5,241,671. It therefore appears that Encyclopaedia Britannica, Inc. asserts ownership of the abandoned Serial No. 08/113,955. No adverse claim is evident.

2. **Attorneys for Serial No. 08/113,955:** No power of attorney for Serial No. 08/113,955 appears to have been filed, although the "Change of Correspondence Address / Application" filed November 9, 2007, was signed by Jon D. Grossman, who asserted he was an "Attorney or agent of record." PAIR shows that the current correspondence address for Serial No. 08/113,955 is Dickstein Shapiro LLP, 1825 Eye Street NW, Washington DC 20006-5403, but states "No Attorney / Agent Data Found".

3. **Petitioners:** The present Petition (the "Petition") was filed November 1, 2007, by Petitioner Abraham HersHKovitz, a patent agent, Registration No. 45,294, of HersHKovitz & Associates, LLC, 2845 Duke Street, Alexandria, VA 22314. Mr. HersHKovitz claims no formal connection to Dickstein Shapiro LLP or Encyclopaedia Britannica, Inc., and does not claim to have personal knowledge of the facts concerning the prosecution of Serial No. 08/113,955, but he

does appear to be acting on behalf of Dickstein Shapiro LLP and/or Encyclopaedia Britannica, Inc.

A prior petition (the "Grossman Petition") was filed October 29, 1993, by Petitioner Jon D. Grossman, a patent attorney, Registration No. 32,699. The Grossman Petition was dismissed February 16, 1994.

4. **Opposer:** This Opposition is filed by Raymond W. Green, a patent attorney, Registration No. 24,587, and a shareholder of the law firm BRINKS HOFER GILSON & LIONE, P.O. Box 10395, Chicago, Illinois 60610, 312-321-4200. BRINKS HOFER GILSON & LIONE represents defendants (Alpine Electronics, Inc. and Alpine Electronics of America, Inc.) in pending litigation in the U.S. District Court for the Western District of Texas (see below), in which Encyclopaedia Britannica, Inc. asserts that patents that claim the priority of Serial No. 08/113,955 are infringed.

#### **B. FILING OF LAWSUITS**

The following facts in Paragraphs 5-8 are shown by documents filed in lawsuits pending in the U.S. District Courts for the Western District of Wisconsin and the Western District of Texas (Austin Division).

5. *Encyclopaedia Britannica, Inc. v. Alpine Electronics of America, Inc., Alpine Electronics, Inc., Denso Corporation, Toyota Motor Sales, U.S.A., Inc., American Honda Motor Co., Inc., and Garmin International, Inc.*, Civil Action No. 05-cv-359, filed May 16, 2005 in the Western District of Texas, alleges that Reed et al. Patents 5,241,671 and 7,051,018, the latter of which claims the priority of Serial No. 08/113,955, are infringed.

6. *Encyclopaedia Britannica, Inc. v. Alpine Electronics of America, Inc., Alpine Electronics, Inc., Denso Corporation, Toyota Motor Sales, U.S.A., Inc.,*

*American Honda Motor Co., Inc., and Garmin International, Inc.*, Civil Action No. 06-cv-578, filed July 25, 2006 in the Western District of Texas, alleges that Reed et al. Patent 7,082,437, which claims the priority of Serial No. 08/113,955, is infringed.

7. *Encyclopaedia Britannica, Inc., v. Magellan Navigation TomTom, Inc., and TV & Appliance of Madison, Inc.*, Civil Action No. 07-cv-285, filed May 21, 1007, in the Western District of Wisconsin, was transferred to the Western District of Texas, Austin Division, where it is pending as Civil Action No. 1:07-cv-787. Encyclopaedia Britannica alleges that Reed et al. Patents 7,051,018 and 7,082,437, both of which claim the priority of Serial No. 08/113,955, are infringed.

8. In *Encyclopaedia Britannica, Inc., v. Magellan Navigation et al.*, Civil Action No. 1:07-cv-787, Defendants Magellan Navigation and TomTom, Inc. filed a Motion for Summary Judgment on October 5, 2007, asking for judgment that the effective filing dates of Reed et al. Patents 7,051,018 and 7,082,437 are no earlier than February 28, 1994, and that the patents are invalid as anticipated by Encyclopaedia Britannica (Reed et al.) International (PCT Patent Application) Publication WO 91/06916, published May 16, 1991, which claims the priority of Encyclopaedia Britannica (Reed et al.) Application Serial No. 07/426,917. A copy of the Motion was submitted with the Petition. Copies of subsequent papers filed in Court, relating to the Motion, will be provided on request.

Abandoned Incomplete Application Serial No. 08/113,955, Deposited August 31, 1993  
Appendix B to Opposition filed January 9, 2008, to Petition for a filing date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Office of Petitions**

Applicant:	Michael Reed et al.	:	Confirmation No. 3543
		:	
Serial No.:	08/113,955	:	Art Unit: UNASSIGNED
		:	
Deposited:	August 31, 1993	:	Examiner: UNASSIGNED
		:	
For:	MULTIMEDIA SEARCH SYSTEM	:	

**APPENDIX B TO OPPOSITION TO  
“PETITION UNDER 37 C.F.R. §1.53(b) and/or 37 C.F.R. §1.182 FOR  
GRANT OF A FILING DATE AND AMENDMENT OF APPLICATION”**

Pages A5-A6:      Petition for Granting Filing Date

Pages A7-A8:      Preliminary Amendment

Pages A9-A10:    1994 Decision on Petition

PATENT  
Docket No. E4800.001/P001A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of  
Michael REED et al.

Serial No.: 08/113,955

Examiner: NOT YET ASSIGNED

Filed: August 31, 1993

Group Art Unit: NOT YET ASSIGNED

For: MULTIMEDIA SEARCH SYSTEM

PETITION FOR GRANTING FILING DATE

The Honorable Commissioner  
of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This Petition is provided under MPEP 608.01. The above-identified application was filed without all pages of the specification. In particular, page 1 of the specification, which provides a description of the background of the invention, was found to be missing by the Patent and Trademark Office. Although applicant believes that this page was included, it is submitted that this page is not necessary for an understanding of the subject matter sought to be patented or for support of the claims. Applicant thereby petitions to have the application accepted without the omitted page.

This Petition is accompanied by a Petition fee under 37 C.F.R. §1.17(h) and an amendment cancelling from the specification all incomplete sentences. Again, no claims depend upon the omitted page of the disclosure for support. Moreover, an Oath or Declaration has not yet been filed in this matter. An Oath or

41166

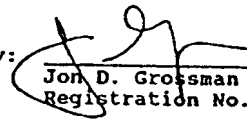
Abandoned Incomplete Application Serial No. 08/113,955, Deposited August 31, 1993  
Appendix B to Opposition filed January 9, 2008, to Petition for a filing date

Declaration will also be filed following the date of Petition and  
Amendment including specific reference to the Amendment cancelling  
from the specification all incomplete sentences.

Respectfully submitted,

DICKSTEIN, SHAPIRO & MORIN

By:

  
Jon D. Grossman  
Registration No. 32,699

2101 L Street, N.W.  
Washington, D.C. 20037  
(202) 828-2279  
Date: October 29, 1993

41166

PATENT  
Docket No. E4800.001//P001A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of  
Michael REED et al.

Serial No.: 08/113,955

Examiner: NOT YET ASSIGNED

Filed: August 31, 1993

Group Art Unit: NOT YET ASSIGNED

For: MULTIMEDIA SEARCH SYSTEM

PRELIMINARY AMENDMENT

The Honorable Commissioner  
of Patents and Trademarks  
Washington, D.C. 20231

Sir:

Please preliminarily amend the above-identified  
application prior to examination on the merits as follows:

IN THE SPECIFICATION

Please renumber the pages of this application beginning on  
page 1 through page 68 which should now be renumbered pages 2-67.

On page 2, lines 1-2, please delete "the combination of  
search strategies to uncover graphical and related textual  
information or vice versa. Other limitations" to --Limitations--.

REMARKS

The application now is in condition for examination. In  
the event that the Examiner has any questions pertaining to this  
Preliminary Amendment, he is urged to contact Applicant's

41241

undersigned representative in order to expedite any remaining  
issues in the prosecution of this application.

Respectfully submitted,  
DICKSTEIN, SHAPIRO & MORIN

By: Jon D. Grossman  
Registration No. 32,699

2101 L Street, N.W.  
Washington, D.C. 20037  
(202) 828-2279  
Dated: October 29, 1993

41241



Abandoned Incomplete Application Serial No. 08/113,955, Deposited August 31, 1993  
Appendix B to Opposition filed January 9, 2008, to Petition for a filing date



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER OF  
PATENTS AND TRADEMARKS  
Washington, D.C. 20231

FEB 1 1994

#4

Dickstein, Sharpiro & Morin  
2101 L Street, N.W.  
Washington, DC 20037

In re Application of :  
Michael Reed et al. :  
Serial No. 08/113,955 :  
Deposited: August 31, 1993 : DECISION ON PETITION  
For: MULTIMEDIA SEARCH SYSTEM :

This is a decision on the petition filed October 29, 1993, requesting that the above-identified application be accorded a filing date of August 31, 1993.

The application was deposited on August 31, 1993. However, on September 14, 1993, Application Division mailed a letter requiring page 1 of the specification and stating that the filing date would be the date of receipt of the omitted page. An oath or declaration in compliance with 37 CFR 1.63, \$710.00 for the basic filing fee, \$1,446.00 for additional claims and the \$130.00 surcharge, if necessary, were also required.

In response, on October 29, 1993, the present petition was filed. Petitioners argue, in effect, that page 1 of the specification is not necessary to understand the claimed subject matter. The petition is accompanied by an amendment canceling the incomplete sentence on page 2 of the specification and renumbering the pages present on August 31, 1993.

As set forth in MPEP 608.01, an application is considered incomplete, if it omits one or more pages of the specification. Since the application, as deposited, omitted page 1 of the specification, the application is prima facie incomplete in the absence of that page. While the petition argues that the omitted page is unnecessary for an understanding of the claimed subject matter, the petition was not accompanied by an oath or declaration by the inventors as required by MPEP 608.01 at pages 600-28 and 600-29.

At present, the petition is dismissed. However, this decision is made without prejudice to reconsideration upon the filing of a request therefor. If the inventors agree that page 1 is unnecessary for an understanding of their invention, the

Abandoned Incomplete Application Serial No. 08/113,955, Deposited August 31, 1993  
Appendix B to Opposition filed January 9, 2008, to Petition for a filing date

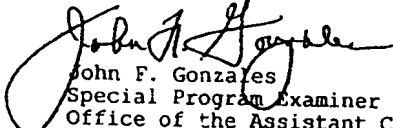
Serial No. 08/113,955

Page 2

application may be accorded a filing date of August 31, 1993, upon the filing of a request for reconsideration, accompanied by an oath or declaration in compliance with 37 CFR 1.63 by the inventors including a statement that their invention is adequately disclosed in, and their wish to rely on, the application as amended on October 29, 1993, without page 1 of the specification for purposes of an original disclosure and filing date.

Alternatively, if the applicants think page 1 is necessary for an understanding of their invention, the page must be filed accompanied by a supplemental oath or declaration by the inventors referring to the specification originally deposited, as amended to include page 1. In this case, the filing date of the application will be the date of receipt of page 1.

A request for reconsideration (no further petition fee is required) as outlined above or page 1 and the supplemental oath or declaration referring to the page must be filed within TWO MONTHS of the date of this decision in order to be considered timely. See 37 CFR 1.181(f). Failure to file a timely response will result in the return of the application to Application Division for processing as an incomplete application under 37 CFR 1.53(c). The response should be directed to the attention of the Office of the Assistant Commissioner for Patents, Crystal Park Building 2, Room 919, Washington, D.C. 20231.

  
John F. Gonzales  
Special Program Examiner  
Office of the Assistant Commissioner for Patents

JFG